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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,295	06/30/2005	Heribert Orth	720734.00004	8358
7590 Quarles & Brady 411 E. Wisconsin Ave. Milwaukee, WI 53202	06/19/2007		EXAMINER DEUBLE, MARK A	
			ART UNIT 3651	PAPER NUMBER
			MAIL DATE 06/19/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/518,295	ORTH, HERIBERT
	<b>Examiner</b>	<b>Art Unit</b>
	Mark A. Deuble	3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 and 9 is/are rejected.
- 7) Claim(s) 6-8 is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 12/16/2004
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the row of compartments" in line 7. There is insufficient antecedent basis for this limitation in the claim. It appears that lines 3-4 of the claim fail to provide proper antecedent basis for this term because the lines recite a row of components rather than a row of compartments as would be required to provide proper antecedent basis.

Claim 2 states that "the distance between the discharge end of the feed device and the top edge of the partitions between the compartments is greater than half the length off the products, as measured in the movement direction." This limitation renders the scope of the claim impossible to ascertain because the claims are directed to an apparatus for forming stacks and not to the combination of apparatus and the objects to be stacked. A size relationship between a part of the conveyor apparatus of the present invention and something that is not part of the apparatus of the present invention may not be claimed because a person operating a similar conveyor apparatus could be guilty of infringing such an apparatus claim depending on a method of using apparatus rather than on the structure of the apparatus as is usually required for infringement of an apparatus claim. For example, a person may be guilty of infringing on the present apparatus claim by using a similar apparatus to stack objects having one size and not be guilty of infringing

the present apparatus when using the similar apparatus to stack larger objects. Such a relationship may be more appropriately in a claimed directed to a method of using the conveyor apparatus to convey items with a definite size relationship to the cylindrical guide element. Furthermore, it should be noted that the material or article worked upon does not limit apparatus claims. See MPEP §2115.

"Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d \*>996<, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

Regarding claim 3, the phrase "and are preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by European document number EP 0 995 702 A1.

The European document shows an apparatus which could be used for forming stacks of products in an essentially horizontal and continuously movable row of compartments 9. The products are fed to the compartments by a feed device 2 which conveys individual products one behind the other to a discharge location above the row of compartments and allows the products

to drop into the compartments. A guide device 8 with two directing elements formed by opposite sides of a slot 14 is arranged such that it is only active in the region of the transfer location between the feed device and the row of compartments. The directing elements are arranged such they form an extension of the compartment of the row of compartments that is assigned to the discharge location so that they guide each product between the discharge location of the feed device and the compartment 9 assigned to the product. These directing elements are fitted on a chain of drive mechanism 15 so that they may be moved along synchronously with the row of compartments. Given the size of the products illustrated in Fig. 1, it appears that the distance between the discharge end of the feed device and the top edge of the partitions between the compartments is greater than half the length of the products as measured in the movement direction. Furthermore, even assuming for the sake of argument that such a size relationship is not clear from the figure, it is clear that the apparatus could be used with products having a length that would make the distance between the discharge end of the feed device and the top edge of the partitions between the compartments is greater than half the length of the products as measured in the movement direction. Thus the European document shows all the structure required by claims 1-5 and 9.

***Allowable Subject Matter***

5. Claims 6-8 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited prior art not discussed above shows apparatuses for forming stacks which are similar to that of the present invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Deuble whose telephone number is (571) 272-6912. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene O. Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit 3651

md

